

"communication dated 6/26/00". For the Examiner's convenience, Applicant attaches hereto a copy of the "communication dated 6/26/00" including claims 94-97.

### Objection

The Office Action objected to claims 89-91 as being "improper method 'use' claims". Applicant has amended claims 89-91 herein, obviating the objections.

### Restriction Requirement

Preliminarily, as discussed with the Examiner, the grouping of claims set forth in the Office Action presently outstanding fails to account for several pending claims. Applicant respectfully proposes the assignment of claims (including amended claims 89-91) to groups as follows:

- |           |                                   |
|-----------|-----------------------------------|
| Group I   | Claims 78-81 and 93-102           |
| Group II  | Claims 68-77, 82, 92, and 103-105 |
| Group III | Claims 43, 44, 90 and 91          |
| Group IV  | Claim 45 and 89                   |
| Group V   | Claim 46                          |

Applicant proceeds on the assumption that the foregoing grouping of claims is acceptable to the Patent Office and respectfully invites the Examiner to contact the undersigned if this assumption is incorrect.

The Examiner required Applicant to elect one of five patentably distinct inventions for examination. The Office Action alleges that each of the inventions is distinct because, *inter alia*, "they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects . . ." (Office Action at page 3).

Applicant provisionally elects herein Group I, "drawn to a double stranded RNA, classified in class 536, subclass 23.1". As set forth above, Applicant respectfully asserts that Group I encompasses claims 78-81 and 93-102.

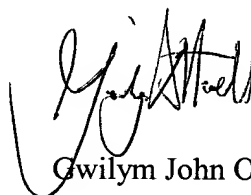
Notwithstanding the foregoing, Applicant respectfully submits that no serious burden would be imposed upon the Examiner by combining several of the groups.

Applicant reserves the right to prosecute the claims encompassed by any of the non-elected groups in future divisional applications.

Attached hereto is a marked-up version of the changes made to the application by the current amendment. The attached page is captioned **"Version with markings to show changes made."**

The examination of these claims and passage to allowance are respectfully requested. An early Notice of Allowance is therefore earnestly solicited. Applicant invites the Examiner to contact the undersigned at (215) 665-6904 to clarify any unresolved issues raised by this response.

Respectfully submitted,



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Attachment: Copy of Preliminary Amendment mailed June 23, 2000

## VERSION WITH MARKINGS TO SHOW CHANGES MADE

## In the Claims:

Please amend claims 89-91 as follows:

Claim 89 (Twice Amended) [Use of said] A method of treating a patient having a disease characterized by the undesired production of a protein encoded by a mRNA comprising administering to said patient a pharmaceutically effective amount of the ribonuclease of claim 74 [for treating an organism having a disease characterized by the undesired production of a protein encoded by a mRNA] and a pharmaceutically effective amount of an oligomeric compound comprising at least twelve ribofuranosyl nucleoside subunits in a sequence which is specifically hybridizable with said mRNA.

Claim 90 (Twice Amended) [Use of said] A method for determining the presence of a mRNA in a comprising incubating the sample with the ribonuclease of claim 74 [for identifying one of a mRNA or a protein encoded by said mRNA] and an oligomeric compound comprising at least twelve ribofuranosyl nucleoside subunits in a sequence which is specifically hybridizable with said mRNA, the presence of one or more degradation products of said mRNA following said incubation being indicative of the presence of said mRNA in said sample.

Claim 91 (Amended) [Use of said ribonuclease of claim 74] A method for diagnosing an aberrant state in an organism associated with a protein encoded by a mRNA, said method comprising incubating a sample from said organism with the ribonuclease of claim 74 and an oligomeric compound comprising at least twelve ribofuranosyl nucleoside subunits in a sequence which is specifically hybridizable with said mRNA, the presence of one or more degradation products of said mRNA following said incubation being diagnostic of the aberrant state in the organism.